

REMARKS

The Rejection under 35 U.S.C. §103

The rejection of claims 1-7, 9 and 13-23 under 35 U.S.C. §103, as being obvious over Schoen (US Pub. No. 2002/0192448 or U.S. Patent No. 6,884,289) in view of Andes (US Pub. No. 2003/0005859), is respectfully traversed. The '289 patent is the patent which issued from the '448 publication. Thus, these documents have the same disclosure and will be discussed as one together, with any references made to the patent.

Applicants submit that the comments in the Final Office action show that applicants' previous arguments have been misinterpreted. Thus, applicants reiterate and further expand on their reasons for patentability over the cited references.

Applicants previously pointed out that the "absorbent 'covering' (D) of Schoen is a collection of discrete particles on the surface of the pigment rather than a contiguous layer." Applicants point was that Schoen uses the term "layer" differently than used by applicants in the instant claims. The "layer" in Schoen consists of particles which are not contiguous with each other, i.e., the particles must remain as discrete individual particles in Schoen. The response in the Final Office action is that the layer (D) is "contiguous with the preceding layer." This response thus misses the applicants' point of distinction. While Schoen uses the term "layer" to describe its element (D), it is clear that Schoen defines the term layer to include a mere collection of discrete particles on the surface rather than a contiguous smooth layer.

Just because both the reference and the instant claims use the same term "layer" does not mean they have the same meaning in each. Schoen's use of the term layer (D) only refers to a

layer which is a collection of discrete individual particles. The Office action appears to be alleging that the “absorbent layer” term in the instant claims would encompass such a collection of discrete individual particles because the Office action alleges that the claims can be given their “broadest interpretation.” Applicants respectfully disagree and submit that the claims must be given their broadest reasonable interpretation in light of applicants’ specification. Applicants’ specification describes its absorbent layer (D) as having a particular layer thickness and as being provided as a “coating”; see, e.g. page 3, paragraph [0011], page 6, paragraph [0024]. Further the specification describes that the absorbent layer is provided in applicants’ pigments from solution in a wet chemical method; see, e.g., pages 7-8, paragraphs [0027] – [0029], and the preparation examples at pages 11-17. The only reasonable interpretation one of ordinary skill in the art would take from these disclosures is that the absorbent layer is provided as a contiguous, uniform layer and cannot be an aggregation of discrete pigment particles.

In view of the above clarification of applicants’ arguments, applicants expand on their previous arguments for nonobviousness, as follows.

Schoen fails to disclose or suggest an interference pigment having an “an absorbent layer having a layer thickness of 1 – 100 nm, which comprises at least one: titanium oxynitride or titanium nitride, or a mixture thereof,” where the term “absorbent layer” is given its broadest reasonable interpretation in view of applicants’ specification. The “absorbent layer” term of the instant claim does not encompass a layer of discrete pigment particles as disclosed in Schoen. Thus, both the structure and material of the layer (D) in Schoen must be modified to arrive at the claimed invention. And there is no suggestion in Schoen to modify the pigments disclosed therein to arrive at a pigment with a layer (D) according to the claimed invention.

Schoen discloses that a “covering of absorbent pigment particles having a particle size of 1-500 nm” is included in its pigment. Based on Schoen’s description of this covering as consisting of pigment particles having a certain defined particle size, applicants urge that Schoen fails to disclose or suggest an “absorbent layer” as defined by applicants’ invention. The absorbent “covering” (D) of Schoen is a collection of discrete particles on the surface of the pigment rather than a contiguous layer. Schoen at col. 3, lines 19-20, refers to part (D) of its pigments as a Layer (D) but clearly states that this “layer” “consists of absorbent pigment particles” having a certain particle size. Thus, it is clear that part (D) of the Schoen pigments is not an absorbent layer, as such would normally be defined or as such would be defined by the instant claim term in view of the instant disclosure.

Further, Schoen provides no suggestion, whatsoever, that its covering of absorbent particles comprise at least one of: titanium oxynitride or titanium nitride, or a mixture thereof. Schoen discusses the absorbent material particles at col. 3, lines 19-36, and gives no hint of the use of such materials for the particles.

Andes discloses a pigment having a substrate and two colorless dielectric layers and then an absorbent layer. Andes does not disclose or suggest adding an absorbent layer to a pigment having three colorless dielectric layers of alternating refractive index. Thus, Andes does not disclose or suggest the pigments of the instant claims. Andes discloses a variety of possible materials for its absorbent layer; see, e.g., page 3, paragraphs 0038-0042.

There is no suggestion or reasoning why one of ordinary skill in the art would substitute the covering of absorbent particles in Schoen’s pigment with the absorbent layer of Andes. The Schoen pigments require that the adsorbent covering be provided by pigment particles.

Substituting such a covering of particles with a layer as described by Andes would be contrary to the teachings of Schoen and, thus, one of ordinary skill in the art would not be motivated to make such a modification. No other reasoning is provided or apparent on the record to support why one of ordinary skill in the art would make such a modification. There is no suggestion from Andes that the adsorbent layer therein would provide particles, as opposed to a contiguous adsorbent layer.

Further, there is no suggestion of why one of ordinary skill in the art would select, in particular, titanium oxynitride or titanium nitride materials from the long list of possible adsorbent materials provided by Andes. It was alleged in the previous Office action that Schoen does not specify any particular adsorbent material for its pigments and, therefore, it would have been obvious to use any adsorbent material. Applicants respectfully disagree that Schoen did not specify any particular adsorbent material. As discussed above, Schoen specifically requires that the adsorbent covering be a covering of discrete pigment particles having a particular particle size. Such covering of particles is distinct from the adsorbent layer disclosed by Andes. Further, Schoen does give guidance as to its intention of adsorbent pigment particles by the several examples it gives; see, e.g., col. 3, lines 19-36. There is no suggestion, therefrom, to provide an adsorbent layer nor, particularly, a layer of titanium oxynitride or titanium nitride material.

In the Final Office action it is alleged that it would have been obvious for one of ordinary skill in the art to select any of the list of adsorbent materials from Andes for use in Schoen because they are individually listed. In light of the decisions in In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992) and In re Baird, 29 USPQ2d 1550 (Fed. Cir. 1994) (which take precedence over the decisions cited in the Office action), applicants urge that is not necessarily always obvious to

select any species from a broad disclosure in a reference. The teachings must be considered as a whole as to whether they fairly suggest the selections necessary to arrive at the claimed invention. In light of the above discussion, it is urged that there is no fair suggestion to use one of the particular materials listed in Andes as an absorbent layer in the Schoen pigments because such a selection would require modifying not only the chemical composition of the materials used in Schoen but also the structure of the materials used for the element (D) in Schoen, i.e., substituting materials which would not result in the layer of discrete pigment particles required by Schoen.

For all of the above reasons, it is urged that the teachings of Schoen and Andes, as a whole, fail to render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejection under 35 U.S.C. §103 should be withdrawn.

The Obviousness-type Double Patenting Rejection

The obviousness-type double patenting rejection of claims 1-7, 9 and 13-23 over claims 1-11 of U.S. Patent No. 6,884,829 (Schoen et al.) in view of Andes (US Pub. No. 2003/0005859) is respectfully traversed. These references are the same as the ones discussed above in traversing the obviousness rejection. The remarks from the traversal of the obviousness rejection above are incorporated herein by reference. For those same reasons, it is urged that the obviousness-type double patenting rejection is not supported and should be withdrawn. Since consideration of the full disclosures of Schoen in view of Andes does not render the claimed invention obvious, the claimed invention cannot be an obvious variant of the claims of the Schoen reference viewed in light of Andes.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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